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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/508,083	07/03/2000	WOLF GEORG FORSSMANN	P65123US0	8457

136 7590 04/07/2004

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EXAMINER

SCHNIZER, HOLLY G

ART UNIT

PAPER NUMBER

1653

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/508,083	Applicant(s) FORSSMANN ET AL.	
	Examiner Holly Schnizer	Art Unit 1653	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 13 November 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 78-94.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.

10. ☒ Other: PTOL - 413 -

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KS
Holly Schnizer

Continuation of 3. Applicant's reply has overcome the following rejection(s): the rejection under 35 U.S.C. 112, 1st paragraph and the rejection of Claims 64 and 66-67 under 35 U.S.C. 102(b) as anticipated by Habener. Habener does not teach a method of treating insulin independent diabetes and therefore does not anticipate Claims 82 and 83-84 (which correspond to previous Claims 64 and 66-67).

Continuation of 5. does NOT place the application in condition for allowance because: Claims 78-81 and 85-94 are identical to cancelled claims 60-62 and 68-77 which were rejected as anticipated over Danley et al. Danley et al. teach a compound having the formula of SEQ ID NO:1. Applicant's argument that Danley et al. does not teach the amide modification at the C-terminus is not persuasive because Danley et al. teaches that derivatives of the peptides taught therein can be made including those wherein the C-terminal carboxyl group forms a carboxamide (p. 16, lines 48-53). Danley et al. teaches how to make such carboxamide derivatives (p. 17, lines 28-30). Danley et al. also anticipates claims 82-84 as amended since Danley et al. teaches using the disclosed peptides to treat insulin-independent diabetes (p. 17-18). Thus, Claims 78-94 are anticipated by Danley et al. Habener et al. also teaches a compound having the formula of SEQ ID NO: 1. Applicant's argument that Habener does not teach a C-terminal amide is not convincing since Habener claims amide derivatives of the peptides disclosed therein (see claim 1, part B(4)). Thus, Claims 78-80 and 85-94 are considered anticipated by Habener.